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Attorney Docket No. 064112-0272131

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Andy Laats, et al.  
Serial No: 09/608,985  
Filed: June 30, 2000  
Title: STRAP RETENTION SYSTEM  
AND USES THEREFOR

) Examiner: S. Vidovich

) Art Unit: 3727

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) Hon. Commissioner of Patents and Trademarks,  
) Washington D.C. 20231 on July 15, 2002.

) By: Kim A. Cabello  
) Kim A. Cabello

Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

Appellants respectfully submit herewith this Appeal Brief, in triplicate, pursuant to 37  
CFR §1.192.

**I. REAL PARTY IN INTEREST**

The real party in interest is Nixon, Inc., a California corporation.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to the Appellants or to Appellants' counsel.

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### **III. STATUS OF CLAIMS**

Claims 1, 3-10, 12 and 16-19 remain pending in the application. All of these claims have been finally rejected and are at issue in this Appeal. A copy of the pending claims is attached as Appendix A to this Brief. Claim 1 is an independent claim directed to a fastening and retention system for a strap. Claims 3-10, 12, and 16-17 depend from Claim 1 and are also directed to a fastening and retention system for a strap. Claim 18 is an independent claim directed to a fastening and retention system for a strap used in conjunction with a wrist-borne device. Claim 19 is an independent claim directed to a retention loop.

### **IV. STATUS OF AMENDMENTS**

One amendment has been filed, dated June 30, 2000. This amendment added drawing figures 9-11. This amendment also added reference numerals to the specification to conform to the new drawing figures. Lastly, this amendment canceled claims 2, 11, 13-15 and added claims 18 and 19. The Examiner entered the amendment adding new claims 18 and 19 and canceling claims 2, 11 and 13-15. The Examiner did not enter the new drawing figures and the amendments to the specification.

### **V. SUMMARY OF THE INVENTION**

The claimed invention is directed to a fastening and retention system for a strap, such as a watch strap. The system includes a first strap and a second strap. The first strap includes a securing mechanism, such as a buckle, configured to receive and secure the end of the second strap. One or more retention loops are slidably mounted on the first strap. At least one of the retention loops includes a first component of a mating structure and the second strap includes a complementary second component of the mating structure. One of the mating structure components comprises a protruding member and the other mating structure comprises an aperture sized to mate with the protruding member. When the second strap is secured to the first strap by the securing mechanism and the mating structures are mated, the end of the second strap

is maintained in close contact with first strap and the retention loop or loops are prevented from sliding freely along the strap.

**VI. ISSUES**

Whether the drawing figures and amendments to the specification submitted in the amendment dated August 31, 2001, constitute new matter under 35 U.S.C. §132.

Whether the subject matter of claims 1, 3-10, 12 and 16-19 is described in such a way as to enable one of ordinary skill in the art to make and use the invention, as required by 35 U.S.C. §112, first paragraph.

Whether claims 1, 3-10, 12 and 16-19 particularly point out and distinctly claim the subject matter that the applicant regards as the invention, as required by 35 U.S.C. §112, second paragraph.

Whether claims 1, 3, 5-10 and 19 are anticipated 35 U.S.C. §102(b) by Miller, U.S. Patent No. 1,100,389.

Whether claims 4, 16 and 17 are obvious under 35 U.S.C. §103(a) in view of Miller.

Whether claims 12 and 18 are obvious under 35 U.S.C. §103(a) in view of Miller and Wollman, U.S. Patent No. 4,664,533.

**VII. GROUPING OF THE CLAIMS**

All claims on this appeal stand or fall together.

**VIII. ARGUMENTS**

*1. New Matter*

Applicants respectfully submit that Examiner erred as a matter of law in not approving the clarification drawings and substitute specification. Amendments to patent applications are

not new matter unless they disclose an invention, process or apparatus not previously described. Here, it is applicants' position that the "new matter" simply clarified and completed the prior disclosure from the original application, and therefore cannot be treated as new matter under 35 U.S.C. §132.

The Examiner stated in the Office Action dated October 19, 2001 (the second office action) that "Applicant clearly has no support in the originally filed application for the proposed illustrations and any proposals to illustrate the claimed subject matter by applicant will be held as introducing new matter." (Page 2, 4 lines from bottom). This argument is undoubtedly incorrect, however, as it overlooks the fact that an amendment to an application is not new matter under 35 U.S.C. §132 unless it discloses an invention, process or apparatus not previously described.

It is proper to amend the specification and drawings of a pending application to conform to each other, and that added matter will not be deemed technical "new matter" within the prohibition of law.<sup>1</sup>

Applicants' amendment simply amended the drawings and specification in response to the Examiner's queries in the Office Action dated May 14, 2001 (the first office action). The amendment merely inserted reference characters into the specification and added drawing figures having elements responding to the elements clearly described in the specification. The applicants added no disclosure beyond what was already in the specification.

All amendments to the specification, *including the claims*, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of filing the application.<sup>2</sup> (emphasis added) Therefore, where a patent application as filed contains a claim that specifically discloses something not disclosed in the descriptive part of the

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<sup>1</sup> In re Heinle, 342 F.2d 1001 (C.C.P.A. 1965).

<sup>2</sup> 37 C.F.R. 1.118

specification, an applicant may amend the specification without being charged with adding “new matter” within the meaning of 35 U.S.C. §132.<sup>3</sup>

Applicants’ original specification, including the claims, was more than adequate to explain applicant’s invention. Original Claim 1 disclosed a strap with two ends, a securing mechanism, a retention loop, and a mating structure between the retention loop and the strap. The securing mechanism secures one end of the strap, but leaves one strap end free. The retention strip and the free end each contain components of a mating structure. When mated, the retention strip is not free to move along the strap, and the free end is held closely against the strap. Original Claim 2 disclosed a mating structure wherein one component is a protruding member and the other component is a slot for receiving the protruding member. Anyone who has ever seen a belt or a watch band would know immediately what was being described and claimed.

From these two claims alone it is clear to envision applicants’ invention. The invention is a novel retention loop and mating structure to keep the free end of a strap held closely against the strap, and keep the retention loop from sliding along the strip.

The Examiner stated in the first office action that the subject matter must be shown in the drawings or that the features should be canceled from the claims. Applicants accordingly added figures 9-11 to respond to the Examiner’s request and clarify the original disclosure. Figures 9 and 10 show the interrelationship of the straps, the securing mechanism, and the retention strip as described in original Claim 1. They also show the mating structure as described in original claims 1 and 2. The amendment also incorporated the limitations of claim 2 into claim 1 to better clarify applicants’ invention. Figure 11 was added, showing a watch attached to the straps, as described in the original specification at page 3, lines 14-22. The detailed description was slightly amended, adding reference numerals and a few superficial changes to correspond to the reference numerals of the new drawings.

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<sup>3</sup> In re Benno, 768 F.2d 1340 (Fed. Cir. 1985).

Applicants are at a loss to see any possible way that the changes to the drawings or description could be deemed new matter. All of the elements in the new drawings were elements from the original claims. The only change to the specification was the addition of reference characters to the words already there. Since all of the reference numerals corresponded to reference numerals on the new drawings, the elements in the new drawings could not be new.

Therefore, there was no appropriate basis for holding that the added drawings introduced new matter. All of the items in the drawing and their correspondence to one another were disclosed in the original application. Accordingly, the new drawings were not “new matter” as defined by 35 U.S.C. §132. Consequently the Examiner’s refusal to accept the new drawings was an error as a matter of law.

Applicants respectfully request that the changes to the drawings and specification from Amendment A be entered so that applicants may effectively prosecute their patent application.

*2. Rejections under 35 U.S.C. §112, first paragraph*

Claims 1, 3-10, 12, and 16-19 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

Claims 6-10, 16, 17 and 19 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification and claims in the original application plainly describe the applicants’ invention to any person who is the least bit familiar with belts or watch bands. As set forth above with respect to the new matter issue, the claims defined each of the claim elements and their relationship with one another; the specification described very clearly the invention. The straps and “securing mechanism” are described in detail at page 2, line 25, to page 3, line 22.

The “retention loop” is described in detail at page 3, line 23, to page 4, line 6. The “mating structures” are described in detail at page 4, line 7 to line 26. The applicants respectfully submit that any person skilled in the art would be able to make and use the claimed subject matter with the description provided in the original specification and claims.

*3. Rejection under 35 U.S.C. §112, second paragraph*

Claims 1, 3-10, 12, and 16-19 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

The Examiner’s arguments on this subject in the second office action are difficult to understand. One of the Examiner’s arguments appears to confuse the requirements of 35 U.S.C. §112, second paragraph, with those of 35 U.S.C. §112, first paragraph. The Examiner’s other argument is that the applicants’ argument with respect to a 35 U.S.C. §103 rejection based upon a reference to Swallow somehow renders the claims unclear.

Neither of the Examiner’s arguments is well founded. The first and second paragraphs of 35 U.S.C. §112 are distinct from and independent of each other. By the Examiner’s reasoning, any claim that is rejected under the first paragraph would necessarily be rejected under the second paragraph, which is clearly not the law. The applicants fail to see how arguments about what a reference does or does not teach can render a claim unclear. A claim either is or is not clear. An argument about what a reference would suggest to one of ordinary skill may or may not be accepted by an Examiner. However, an Examiner’s refusal to accept an applicant’s argument does not in any way make the claim unclear under 35 U.S.C. §112, second paragraph.

Applicants’ respectfully submit that the claims clearly and concisely claim the subject matter that applicant regard as the invention. Applicants are at a loss as to how to more clearly explain what they deem to be their invention. The claims are all straightforward, concise, and to the point. There is antecedent basis for every term in the claims. There are no apparent missing

or double words. The words are all spelled correctly. To the extent possible, the claims are grammatically correct. The applicants therefore submit that the claims are allowable under 35 U.S.C. §112, second paragraph.

*4. Rejection under 35 U.S.C. §102*

Claims 1, 3, 5-10 and 19 have been rejected under 35 U.S.C. §102(b) as being anticipated by Miller. The Miller patent discloses a safety device for jewelry. The safety device of Miller comprises an open-yoke frame defined by a bottom bar 6, a top bar 7, and interconnecting side bars 8. A bridge piece 9 extends transversely across the frame to define a lower receiving opening 10 and an upper receiving opening 11. A body portion 1 of a strap is retained in lower receiving opening by the action of a spring arm 12 soldered to bridge piece 9, whereby the yoke frame is fixed to body portion 1 and not slidable thereon. The upper receiving opening 11 has mounted therein to bridge piece 9 a spring-loaded gripping device 15 with a finger piece 19 having a free end that extends outwardly of one of side bars 8. A wearer can clear the upper receiving opening by depressing finger piece 19, which allows an end portion 5 of a strap to pass through the upper opening 11. When finger piece 19 is released, gripping device 15 frictionally traps end portion 5 between gripping device 15 and top bar 7.

Miller fails to teach or suggest several elements of independent claims 1 and 19. The Examiner apparently takes the position that the claimed retention loop corresponds to the yoke frame of Miller and the claimed mating structure corresponds to the gripping device of Miller. However, the yoke frame of Miller does not meet the limitations of the claims. According to claim 1, the retention loop can slide along the strap when the securing mechanism is not engaged, whereas in Miller the yoke frame is fixed on the body portion 1 of the strap whether or not the securing mechanism is engaged. Additionally, Miller does not disclose or suggest either a mating structure including protruding member or an aperture sized to mate with the protruding member as claimed in claim 1. Still further, the gripping device 15 of Miller does not prevent the yoke frame from sliding freely along the strap as claimed in claim 1. In Miller the yoke frame is prevented from sliding along the strap by the spring arm 12, which does not correspond to the claimed mating structure. Similarly, Miller does not include a sliding loop and mating



structure as claimed in claim 19. The yoke frame of Miller does not need to slide on the strap because Miller has no mating structures; the gripping mechanism simply engages the surface of the free end of the strap. In the invention as claimed in claims 1 and 19, the retention loop slides so as to provide alignment for the mating structures. The Miller patent does not teach or suggest the combination of sliding loops and mating structures.

For the above reasons, applicants respectfully submit that Miller does not anticipate applicants' invention as claimed in claims 1, 3, 5-10 or 19.

*5. Rejection under 35 U.S.C. §103*


Claims 4, 16 and 17 have been rejected under 35 U.S.C. §103(a) as being obvious in view of Miller. The Examiner has argued that claims 4, 16, and 17 differ from Miller only with respect to items that are obvious design choices. As explained above, Miller does not teach nor suggest the subject matter of claim 1. Since claims 4, 16 and 17 depend from claim 1, Miller does not disclose nor suggest all of the claimed elements. Accordingly, applicants respectfully submit that claims 4, 16 and 17 of applicants' invention are not obvious in view of Miller.

Claims 12 and 18 have been rejected under 35 U.S.C. §103(a) as being obvious in view of Miller and Wollman. Wollman discloses a watch and bracelet assembly. The Examiner stated that it would have been obvious to modify the Miller design in view of Wollman. The Wollman reference does not teach or suggest the elements missing from Miller as applied to claim 1. Since claim 12 depends from claim 1, the applicants submit that Wollman does not render obvious the subject matter of claim 12. With respect to independent claim 18, the applicants repeat their arguments with respect claim 1. Miller does not teach or suggest the claimed mating structure or the claimed cooperation of the mating structure with the strap. Since Wollman does not supply the missing elements, the applicants submit that the subject matter of claim 18 cannot be rendered obvious by any combination of Miller and Wollman.

*6. Conclusion*

For all of the reasons stated above, Applicants respectfully submit that the pending application is in condition for allowance and request that the Examiner's rejections be reversed.

Respectfully submitted,

  
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Jonathan E. Jobe, Jr.  
Registration No. 28, 429  
PILLSBURY WINTHROP LLP  
11682 El Camino Real, Suite 200  
San Diego, CA 92130  
(858) 509-4005  
Attorney for Applicants



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## APPENDIX

### Claims Pending on Appeal

1. A fastening and retention system for a strap, said system comprising:
  - a) a strap having at a first strap end, a securing mechanism configured to receive a second strap end, and
  - b) one or more retention loops for maintaining, when said second strap end has been secured by said securing mechanism, said second strap end in close contact with a portion of the strap that is proximal to the first strap end,wherein said retention loop(s) can slide along said strap when the strap is not secured by said securing mechanism,  
  
wherein one or more of said retention loops comprises a first component of a mating structure, and said strap comprises a complementary component of the mating structure,  
  
wherein said mating structure comprises a protruding member and an aperture sized to mate with said protruding member, and  
  
wherein said mating structure prevents said loop(s) from sliding freely along said strap when the two components are mated.
2. (Canceled)
3. A system according to claim 1, wherein said protruding member is located on said retention loop, and said aperture for receiving said protruding member is located on said strap.
- 13 refs. (4. A system according to claim 1, wherein said protruding member is located on said strap, and said aperture for receiving said protruding member is located on said retention loop.
5. A system according to claim 1, wherein said strap is configured to receive thereon a device.

6. A system according to claim 5, wherein said device comprises at least one of the following: a wristwatch, an altimeter, a depth meter, a pedometer, a pager, a telephone, a personal data device and a tide meter.

7. A system according to claim 6, wherein said device is a wristwatch.

8. A system according to claim 6, wherein said device is an altimeter.

9. A system according to claim 6, wherein said device is a depth meter.

10. A system according to claim 6, wherein said device is a pedometer.

11. (Canceled)

12. A system according to claim 1, wherein said strap is a two piece strap comprising:

a) a first piece having a first device end and said first strap end, and

b) a second piece having a second device end and said second strap end, wherein said first and second device ends comprise an attachment structure for securing said first and second pieces to a device.

13. (Canceled)

14. (Canceled)

15. (Canceled)

16. A system according to claim 1, wherein said flexible strap comprises at least one of the following materials: leather, rubber and a polymer.

17. A system according to claim 16, wherein said polymer is selected from the following list:

polyurethane, polyurethane/silicon blend, nylon, and polyvinyl chloride.

18. A fastening and retention system, comprising:

a wrist-born device,

a strap having a first end and a second end, the first end including a securing mechanism configured to receive a second end, and the strap being physically connected to the wrist-born device, and

a retention loop for maintaining at least a portion of the second end in contact with at least a portion of the first end,

wherein the retention loop comprises a first component of a mating structure, and the strap comprises a complementary component of the mating structure,

wherein the retention loop can freely slide along the strap when the strap is not secured by the securing mechanism,

wherein the mating structure prevents the retention loop from sliding freely along the strap when the two components are mated.

19. A system comprising:

a retention loop defining an opening,

a first strap passing through the opening,

a second strap passing through the opening,

wherein the retention loops comprises a first component of a mating structure, and the second strap comprises a complementary component of the mating structure,

wherein the mating structure prevents the loop from sliding freely along the straps when the two components are mated.



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By: Kim A. Cabello

Kim A. Cabello

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Appeal to the Board of Patent Appeals and Interferences

PATENT  
APPLICATION

In re PATENT APPLICATION of

Inventor(s): Andy Laats et al.

Appln. No.: 09

Series Code ↑

608,985

Serial No. ↑

Group Art Unit: 3727

Examiner.: S. Vidovich

Atty. Dkt. P 064112

M#

272131

Client Ref

Fil d: June 30, 2000

Title: STRAP RETENTION SYSTEM AND USES THEREFOR

Date: July 15, 2002

Hon. Commissioner of Patents  
Washington, D.C. 20231

Sir:

1. ☐ **NOTICE OF APPEAL:** Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision (not Advisory Action) dated \_\_\_\_\_ of the Examiner twice/finally rejecting claim(s) in this application or in this application and its parent application.
2. ☒ **BRIEF** on appeal in this application attached in triplicate (extendable up to 5 months).
3. ☐ An **ORAL HEARING** is respectfully requested under Rule 194 (due two months after Examiner's Answer- unextendable)
4. ☐ Reply Brief is attached in triplicate (due two months after Examiner's Answer - unextendable).
5. ☒ "Small entity" statement filed: ☐ herewith. ☒ previously.
6. ☐ Fee **NOT** required because paid in prior appeal in which the Board of Patent Appeals and Interferences did not render a decision on the merits (35 USC 134).

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PATENT TRADEMARK OFFICE  
**11682 El Camino Real, Suite 200  
San Diego, CA 92130-2092  
Tel: (619) 234-5000**

By: Atty: Jonathan E. Jobe, Jr.

Reg. No. 28,429

Sig: 

Fax: (858) 509-4010

Tel: **(858) 509-4005**

Atty/Sec: JEJ/kac

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